

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)

PrintCo., Inc.)

Serial No.: 78/155673)

Filing Date: August 19, 2002)

Mark: "ENKLAVVOICE")

Atty. File No.: 4081-131)

Commissioner for Trademarks
P. O. Box 1451
Alexandria, Virginia 22313-1451

T.M. Law Office: 115

T.M. Examiner: Jennifer D. Chicoski

REQUEST FOR RECONSIDERATION

<p>CERTIFICATE OF MAILING</p> <p>I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR TRADEMARKS, P. O. BOX 1451, ALEXANDRIA, VIRGINIA 22313-1451 ON <u>April 25, 2005</u>.</p> <p style="text-align: center;">SHERIDAN ROSS P. C.</p> <p>BY: <u>Chasity C. Rossum</u> Chasity C. Rossum</p>

Dear Commissioner:

In response to the Final Office Action having a mailing date of October 25, 2004, please reconsider the Final refusal to register for the reason that the Specimen of Use is unacceptable in view of the arguments presented herein below. A Notice of Appeal, under separate cover, has also been filed in respect of the above-noted application.

REMARKS

The Applicant thanks the Examining Attorney for the courtesy extended to Applicant's attorney Sabrina C. Stavish for the Examining Attorney's email communication dated December 9, 2004 clarifying her reasons for finding the Specimen unacceptable to prove use. Per the Examining Attorney's December 9, 2004 communication and the Final Office Action having a mailing date of October 24, 2004, please reconsider the refusal to register in light of the remarks presented below.

The Examining Attorney has rejected the Specimen as submitted with the Statement of Use for the reason that the specimen "does not show use of the mark as a service mark for the recited services."

First, the Examining Attorney has stated that based upon the specimen of use submitted, "it is impossible to determine . . . that the applicant is indeed providing a website that allows users to perform the functions outlined in the recitation of services, and as the applicant's advertisement via



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a website of its own products and services would not itself be an activity that meets the definition of a service." 10/25/04 Office Action at *3.

The Applicant respectfully points out to the Examining Attorney that a specimen showing advertising for a service mark is acceptable. TMEP 1301.04. The fact that Applicant's Specimen is an advertisement, therefore, does not preclude the Specimen from being acceptable to prove use for Applicant's services, provided the Specimen meets all other criteria. Applicant also notes that TMEP 1301(b) provides that "[i]n determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant's explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used," citing *In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986). Applicant respectfully requests therefore that the Examining Attorney consider both the Specimen provided and Applicant's below explanations as to how the Specimen is used.

The Specimen consists of two pages from Applicant's website, which advertises and describes Applicant's services. Regarding the Examining Attorney's assertion that "it is impossible to determine . . . that the applicant is indeed providing a website that allows users to perform the functions outlined in the recitation of services," Applicant directs the Examiner's attention to the following portions of the Specimen where the services are explained. Applicant's ENCLAVTDW family of marks including ENCLAVVOICE, provide services for "content management and dynamic publishing system[s]" via "browser based collaboration tools." Specimen, page 1. ENCLAVTDW and family of marks, including ENCLAVVOICE, allows users to "aggregate, organize, authorize and publish content on demand. Images and text can be re-expressed through customized templates for a variety of media." Specimen, page 2. Accordingly, users use the service to ensure consistency of use of "pricing, product images and descriptions, legal boilerplates, and logos" in "sales kits, catalogs, direct mail, brochures and webpages" between various vendors or departments such as "brand designers, designers, brand channels, and vendors." Specimen, page 2. The ENCLAVVOICE services specifically allows users to "create, populate, approve and manage a

digital warehouse of sales and marketing information. EnclavVoice aggregates all forms of text, data, and images and administers content approvals." Specimen, page 2. In other words, Applicant's customers can subscribe to Applicant's service to create advertisements for their own businesses. Applicant provides access to its web site where its customers can create these advertisements. Applicant makes it easy for customers to create their own advertisements by giving its customers with a starting place for the advertisement. For example, an automobile dealer customer of Applicant would visit Applicant's site (after paying Applicant a fee to access this portion of the site). The automobile dealer could then create an advertisement which already contains information on the automobiles the dealer sells (provided by Applicant) as opposed to having to start from scratch in creating this advertisement. Thus, Applicant provides customers with use of its web site, but does not provide the Applicant with software that is downloadable or on CD ROM.

Accordingly, contrary to the Examining Attorney's assertion, it is possible to determine that the Applicant is providing a website that allows users to perform functions outlined in the recitation of services. The Specimen provides information on the services offered consistent with Applicant's description of the services, i.e., "advertising and marketing services for others, namely providing a website which permits users to create, populate, authorize, and manage databases of sales data and information, marketing data and information, product specifications, product pricing, catalog data, and related sales and marketing content."

The Examining Attorney has further stated, in the Examining Attorney's email addressed to Sabrina Stavish dated December 9, 2004, that "it is not clear from the text on the specimen if that something [i.e., services offered by Applicant] is software that one gets to purchase on a CD-ROM and load on their own machine or if it is access to a different website where the service can be used." Applicant respectfully disagrees. There is nothing in Applicant's specimen supporting the Examiner's interpretation that what may offered by the Applicant is in fact software that one purchases on a CD-ROM and load on their own machine. Applicant submits that in fact, it very clear from the text of the Specimen that Applicant provides services which are only accessible through the World Wide

Web.

The Applicant states in the Specimen that the services are provided via a website that allows users to perform the functions outlined in the recitation of services. Applicant provides the following statements from the Specimen in support of Applicant's assertion. Specifically, the Specimen states that ENCLAVVOICE IS one of "EnklavTDW's browser-based collaboration tools." Specimen, page 1. Further, the Specimen provides that the services are provided ". . . all through a hosted, secure web portal." In other words, to use the services, after purchasing said services from Applicant, the user accesses the Applicant's website, and then interacts with the Applicant's website to both upload information and to receive Applicant's services through a web portal. Specifically, as described by Applicant in the Specimen, Applicant provides a browser-based collaboration tool called ENCLAVVOICE, through a hosted, secure web portal, which provides Applicant's service consisting of "aggregat[ing] all forms of text, data, and images and administer[ing] content approvals." Specimen, page 2. Accordingly, the text of the Specimen, as well as Applicant's additional explanations, provide clear evidence that the services offered by Applicant are in fact services offered through the World Wide Web.

It is now believed that the case is in condition for publication and such action is hereby respectfully solicited. Should the Examining Attorney be of the opinion that a telephone interview would facilitate the prosecution of the application, please email or telephone the undersigned at (303) 863-9700.

Respectfully submitted,

SHERIDAN ROSS P. C.

Date: April 25, 2005

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